

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) **de Janasz, Christopher G.**
Application **10/563,187**
Confirmation **5857**
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Application Title **Vehicle-Based Wireless Identification System**
Art Unit **3621**
Latest Examiner **Le, Nancy Loan T.**

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Responsive to the Office Action mailed on 12 October 2010 (the “Final Office Action”), Applicant respectfully requests review of the final rejections of claims 1-34. No amendments are being filed with this request. A Notice of Appeal accompanies this request.

I. The Obviousness Rejections

Page labeled 2 through the page labeled 11 of the present Office Action rejects each of claims 1-34 under 35 U.S.C. 103(a) as being obvious over various combinations of U.S. Patent 6,158,655 (“DeVries”), U.S. Patent 6,484,260 (“Scott”), U.S. Patent Application Publication 2003/0220835 (“Barnes”), U.S. Patent 5,748,101 (“Christensen”), U.S. Patent 5,010,485 (“Bigari”), and/or U.S. Patent 5,819,234 (“Slavin”).

Each of these rejections is respectfully traversed in its entirety.

a. Lack of Evidence of a Reason to Combine References

Each of the rejections of each of claims 1-34 in the present Office Action fails to provide substantial evidence of obviousness as required under *KSR*.

To effectively guard against impermissible hindsight, *KSR* emphasized the “import[ance]” of “identify[ing] a **reason** that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (*Id.*, quoting *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”. *See also*, 35 U.S.C. §132 (“Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director **shall** notify the applicant thereof, **stating the reasons for such rejection**, or objection or requirement....” (emphasis added)).

The Federal Circuit has further held that “[w]hen there is a design need or market pressure to solve a problem”, obviousness is not supported unless “a finite, and in the context of the art, small or easily traversed, number of options” “**would** convince an ordinarily skilled artisan of obviousness”. *Ortho-McNeil Pharmaceutical Inc. v. Mylan Laboratories Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008).

Regarding the proffered combination of DeVries and Scott, the present Office Action opines, at numbered page 3:

[i]t would have been obvious and motivated to an ordinary skill in the art at the time the invention was made to add the ‘encryption’ feature as taught in the personal identification system of Scott to the system disclosed in the DeVries reference, to protect data in transit

Thus, the present Office Action argues that the reason to combine the “encryption” of Scott to the system of DeVries is to “protect data in transit”. Applicant respectfully submits that the reason to combine “encryption” with **any system** is to “protect data in transit”. The present Office Action has not provided “a reason that would have prompted a person of

ordinary skill in the relevant field to combine the elements **in the way** the claimed new invention does”.

Regarding the proffered combination of DeVries, Scott, and Barnes, the present Office Action opines, at numbered page 4:

[i]t would have been obvious and motivated to an ordinary skill in the art at the time the invention was made to add the feature ‘causing information associated with the rejection or approval of the proposed financial transaction to be rendered to the user via a user interface’ as taught by the system of Barnes to the combination of the systems of DeVries and Scott to notify the user of the result of the financial transaction

The only reason given by the present Office Action to “render” “information” “to the user” is to “notify the user”. Such an alleged “reason” is instead a blatant use of hindsight, as it defines the solution solely in terms of the problem, and provides no indication that the combination of DeVries, Scott, and Barnes is one of “a finite, and in the context of the art, small or easily traversed, number of options” that “would convince an ordinarily skilled artisan of obviousness”. The present Office Action provides similar “reasons” for the combinations of each of the provided references on each of page 6 to combine DeVries, Scott, Barnes, and Bigari, page 8 to combine DeVries, Scott, Barnes, and Christensen, and page 10 to combine DeVries, Scott, Barnes, Bigari, and Slavin. At no point is any articulated reasoning presented explaining why a person having ordinary skill in the art would choose these specific references out of the multitude of options provided by the prior art. Thus, any combination of these references is based solely on hindsight and is therefore improper.

Finally, the rejections of the present Office Action provide no substantial evidence that the currently claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. That is, the present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the currently claimed subject matter does**. Instead, the present Office Action merely

provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence any stated reason to be art-recognized, each stated reason **must be** based on impermissible hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The claim rejections cannot be sustained properly based upon the mere conclusory statements of the present Office Action.

For at least these reasons, Applicant respectfully requests withdrawal of the rejections of each of claims 1-34.

b. Missing Claim Limitations

Each of independent claims 1, 14, 15, and 34, from one of which each of claims 2-13 and 16-33 ultimately depends, states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the cited references teach (i.e., disclose and enable), alone or in combination, “a signal from a vehicle-powered non-telephonic wireless transmitter...the signal comprising an encrypted unique identifier, the encrypted unique identifier not comprising a financial account number or a user-provided PIN, the signal transmitted responsive to a predetermined input from a user”.

The portions of DeVries cited to reject this subject matter apparently states that the “occupant can use, for example, his or her personal identification number or credit or banking card number” (column 2, lines 21-25). The present Office Action also argues, on numbered page 12, that “Bigari teaches such features”. However, the cited portions of Bigari teaches transmission of “account identification data” and “maximum charge amount”. Thus, neither teaches a “signal” “**not** comprising a financial account number or a user-provided PIN” as claimed. The remaining references fail to remedy this deficiency of Bigari and DeVries.

Thus, even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the present Office Action (an assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the present Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach **every** limitation of the independent claims, and

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consequently the present Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that, in view of the foregoing remarks, the application is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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